

#17  
PATENT  
Docket No. 427922001500

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED  
MAY 06 2003  
GROUP 1700

In the application of:

Torleif O. BJORNSON and Laurence R. SHEA

Examiner: J. Ludlow

Group Art Unit: 1743

Serial No.: 09/509,337

Filing Date: June 13, 2000

For: LAMINATE MICROSTRUCTURE  
DEVICE AND METHOD FOR MAKING  
SAME

**REQUEST TO WITHDRAW AS ATTORNEYS OF RECORD  
UNDER 37 C.F.R. § 1.36**

Commissioner for Patents  
Washington, D.C. 20231

APPROVED *instone*  
JACQUELINE M. STONE  
DIRECTOR  
TECHNOLOGY CENTER 1700

JUN - 4 2003

Dear Sir:

I, Thomas E. Ciotti, attorney of record in the subject patent application, hereby request that the Patent Office approve this request for withdrawal from representation of the applicant of the above-identified application. The assignee has been notified of this request. This request is being made in triplicate by the requester, Thomas E. Ciotti, for himself and on behalf of all attorneys/agents of record, namely:

|   |                                     |
|---|-------------------------------------|
| Lisa A. Amii (Reg No. 48,199)           | Randolph Ted Apple (Reg No. 36,429) |
| Mehran Arjomand (Reg No. 48,231)        | Laurie A. Axford (Reg No. 35,053)   |
| Erwin J. Basinski (Reg No. 34,773)      | Shantanu Basu (Reg No. 43,318)      |
| Richard R. Batt (Reg No. 43,485)        | Vincent J. Belusko (Reg No. 30,820) |
| Jonathan Bockman (Reg No. 45,640)       | Kimberly A. Bolin (Reg No. 44,546)  |
| Barry E. Bretschneider (Reg No. 28,055) | Nicholas Buffinger (Reg No. 39,124) |
| Robert K. Cerpa (Reg No. 39,933)        | Peng Chen (Reg No. 43,543)          |
| Alex Chartove (Reg No. 31,942)          | Thomas E. Ciotti (Reg No. 21,013)   |
| Cara M. Coburn (Reg No. 46,631)         | Matthew M. D'Amore (Reg No. 42,457) |

|   |                                       |
|---|---------------------------------------|
| Raj S. Davé (Reg No. 42,465)            | Peter Davis (Reg No. 36,119)          |
| David Devernove (Reg No. 50,128)        | Karen B. Dow (Reg No. 29,684)         |
| Stephen C. Durant (Reg No. 31,506)      | Christopher B. Eide (Reg No. 48,375)  |
| Carolyn A. Favorito (Reg No. 39,183)    | David L. Fehrman (Reg No. 28,600)     |
| Hector Gallegos (Reg No. 40,614)        | Deborah S. Gladstein (Reg No. 43,636) |
| Debra J. Glaister (Reg No. 33,888)      | Bruce D. Grant (Reg No. 47,608)       |
| Carol M. Gruppi (Reg No. 37,341)        | Alicia Hager (Reg No. 44,140)         |
| Johney U. Han (Reg No. 45,565)          | Laurie Hill (Reg No. 51,804)          |
| Douglas G. Hodder (Reg No. 41,840)      | Alan S. Hodes (Reg No. 38,185)        |
| Charles D. Holland (Reg No. 35,196)     | Arthur S. Hsieh (Reg No. 48,247)      |
| Jill A. Jacobson (Reg No. 40,030)       | Wayne Jaeschke, Jr. (Reg No. 38,503)  |
| Parisa Jorjani (Reg No. 46,813)         | Ararat Kapouytian (Reg No. 40,044)    |
| Richard C. Kim (Reg No. 40,046)         | Cameron A. King (Reg No. 41,897)      |
| Norman R. Klivans, Jr. (Reg No. 33,003) | Glenn Kubota (Reg No. 44,197)         |
| Kawai Lau (Reg No. 44,461)              | Otis Littlefield (Reg No. 48,751)     |
| Hugh H. Matsubayashi (Reg No. 43,779)   | Michael J. Mauriel (Reg No. 44,226)   |
| Mika Mayer (Reg No. 47,777)             | Robert S. McArthur (Reg No. 45,674)   |
| Gladys H. Monroy (Reg No. 32,430)       | Scott C. Moore (Reg No. 52,047)       |
| Philip A. Morin (Reg No. 45,926)        | Kate H. Murashige (Reg No. 29,959)    |
| Martin M. Noonan (Reg No. 44,264)       | Catherine M. Polizzi (Reg No. 40,130) |
| Philip Reilly (Reg No. 41,415)          | James Remenick (Reg No. 36,902)       |
| Robert Saltzberg (Reg No. 36,910)       | Robert E. Scheid (Reg No. 42,126)     |
| Debra A. Shetka (Reg No. 33,309)        | Rebecca Shortle (Reg No. 47,083)      |
| David Smith (Reg No. 39,839)            | Kevin R. Spivak (Reg No. 43,148)      |
| Shannon Thomas (Reg No. 52,285)         | Thomas L. Treffert (Reg No. 48,279)   |
| Brenda J. Wallach (Reg No. 45,193)      | Michael R. Ward (Reg No. 38,651)      |
| E. Thomas Wheelock (Reg No. 28,825)     | Todd W. Wight (Reg No. 45,218)        |
| Eric Witt (Reg No. 44,408)              | David T. Yang (Reg No. 44,415)        |
| Peter J. Yim (Reg No. 44,417)           | Karen R. Zachow (Reg No. 46,332)      |
| Jie Zhou (Reg No. 52,395)               |                                       |

The mailing address for the withdrawing attorneys/agents is as follows:

Morrison & Foerster LLP  
 755 Page Mill Road  
 Palo Alto, California 94304-1018

Please direct all future correspondence to:

Ms. Virginia Griffith  
 1288 Pear Avenue  
 Mountain View, CA 94043

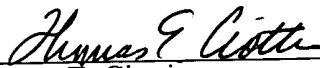
This request is being made at the request of ACLARA Biosciences, Inc. A copy of the confirmation letter by the undersigned directing this change is attached.

To the best of the undersigned attorney's knowledge and belief, there are no outstanding actions in this application requiring response within the next 30 days.

Respectfully submitted,

Dated: April 28, 2003

By: \_\_\_\_\_

  
Thomas E. Ciotti  
Registration No. (21,013)

Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
Telephone: (650) 813-5702  
Facsimile: (650) 494-0792



**NOTICE:**

The information contained in this facsimile message is confidential and subject to attorney-client privilege. It is intended only for the use of the individual named below and others specifically authorized to receive it. If you are not the intended recipient, you are hereby notified that any dissemination, or copying of this communication is strictly prohibited. If you have received this communication in error, please notify the sender at the indicated number immediately and arrange to have the copy returned or destroyed. Thank you for your assistance.

RECEIVED  
MAY 06 2003  
GROUP 1700

16 April 2003

-2-pages in transmission

Via Facsimile

Mr. Richard R. Batt  
Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, CA 94304-1018

Re: Transfer of ACLARA patent applications

Dear Rick,

As we discussed over the telephone, ACLARA has decided to take in-house all patent applications currently being prosecuted by Morrison Foerster. Could you please have the files of the following cases, and any others that you are currently handling for ACLARA, sent to ACLARA to the attention of Ms. Virginia Griffith.

**Applications to be Transferred:**

| MOFO ref.      | ACLARA ref. | Ser. No.       | First Inventor | Title   |
|----------------|-------------|----------------|----------------|---|
| 42792-20015.00 | 019.01US    | 09/509,337     | Bjornson       | Laminate Microstructure Device and Method for Making Same   |
| 42792-20014.01 | 035.01US    | 10/147,940     | Maher          | Multiplexed Fluorescent Detection in Microfluidic Devices   |
| 42792-20014.20 | 035.02US    | 10/202,298     | Maher          | Multiplexed Fluorescent Detection in Microfluidic Devices   |
| 42792-2009-00  | 072.00US    | 09/957,579     | Zhao           | Integrated Microdevices for Conducting Chemical Operations  |
| 42792-2009.20  | 072.01US    | 09/939,327     | Zhao           | Microfluidic Chip Having Integrated Electrodes  |
| 42792-2009-40  | 072.01WO    | PCT/US01/29307 | Zhao           | Microfluidic Chip Having Integrated Electrodes  |
| 42792-2001.40  | 097.00WO    | PCT/US02/17165 | Wevers         | Variable Multi-Channel High voltage Power Source, With Accurate Current Sense                     |
| 42792-20012.40 | 107.00WO    | PCT/US02/21974 | Polosky        | Injection Molding a Flash Free Microfluidic Structure   |
| 42792-0011.40  | 108.00WO    | PCT/US02/19494 | Bjornson       | Submersible Light-Directing Member for Material Excitation in Microfluidic Devices                |
| 42792-20002.40 | 109.00WO    | PCT/US02/24663 | Kao            | Straightflow System   |
| 42792-20013.40 | 112.00WO    | PCT/US02/40442 | Bjornson       | Photoactivation Device and Method   |
| 42792-30016.00 | 127.00USP   | 60/433,183     | Wainright      | Closed Loop Control of Electrokinetic Processes in Microfluidic Devices Based on Optical Readings |

Rick Batt  
Morrison & Foerster  
Page 2

4/16/2003

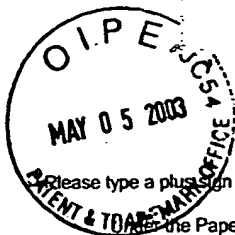
Unfortunately, like many other similarly situated companies, ACLARA is under tremendous pressure to cut costs. One of the ways that we are attempting to do this is by consolidating our microfluidics patent portfolio and handling more of the prosecution in-house.

I want to thank you for the work you have done on ACLARA's behalf. My colleagues and I have been very pleased with the quality of your work and that of Mr. Hodes.

Best regards,

  
Steve Macevich

cc: Ms. Virginia Griffith



1743

PTO/SB/21 (08-00)

Approved for use through 10/31/02. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number Of Pages In This Submission

12

Application Number

09/509,337

Filing Date

June 13, 2000

First Named Inventor

Torleif O. BJORNSON

Group Art Unit

1743

Examiner Name

J. Ludlow

Attorney Docket No.

427922001500

RECEIVED  
MAY 08 2003  
GROUP 1700

## ENCLOSURES (check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☐ Amendment / Reply

☐ After Final

☐ Affidavits/declarations

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/  
Incomplete Application

☐ Response to Missing Parts  
under 37 CFR 1.52 or 1.53

☐ Assignment Papers  
(for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition

☐ Petition to Convert to a  
Provisional Application

☐ Power of Attorney, Revocation  
Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) \_\_\_\_\_

☐ After Allowance Communication to  
Group

☐ Appeal Communication to Board of  
Appeals and Interferences

☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please identify  
below):

1. Request To Withdraw as Attorneys Of  
Record under 37 C.F.R. 1.36 (in  
triplicate) - 9 pages
2. Copy of Confirmation letter - 2 pages
3. Return Receipt Postcard

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm  
or  
Individual Name

Morrison & Foerster LLP, 755 Page Mill Rd., Palo Alto, CA 94304-1018

Thomas E. Ciotti, Reg. No. 21,013

Signature

*Thomas E. Ciotti*

Date

April 28, 2003

## CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on April 29 2003.

*Thao Pham*  
Thao Pham

Burden Hours Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.